

Appl. No. 10/731,937  
Atty. Docket No. CM1976C  
Amdt. dated 10/20/06  
Reply to Office Action of 7/20/06  
Customer No. 27752

#### REMARKS/ARGUMENTS

Claims 1 and 4 are under consideration.

#### Formal Matters

For the record, there are no objections or rejections under 35 USC 112 outstanding.

#### Rejections Under 35 USC 103

Claims 1 and 4 stand rejected over the assertedly "admitted prior art" in view of WO 93/08084, JP 60-28459 Abstract, US 5,200,253, US 5,658,968 and US 4,571,363, for reasons of record at pages 1-6 of the Office Action.

Applicants again respectfully traverse all rejections.

Previous comments regarding the individual citations continue to apply, but will not be repeated herein, for the sake of brevity.

Inasmuch as the Office Action of 7/20/06 has been made Final, Applicants have availed themselves of RCE practice in order to ensure that the following additional comments and rebuttal arguments are made of record prior to any decision to appeal, should an Appeal ultimately prove necessary.

It has previously been argued that the pin-hole/solvent migration/dissolution problem discovered and addressed by Applicants is not suggested in the art. The Examiner's attention had been directed to MPEP 2141.02, noting that the discovery of a problem must be considered as part of the "subject matter as a whole" test under §103.

In response, the Examiner states; "By providing the aluminum layer on the embossed layer by vapor deposition or sputtering, as taught by WO '084 as the methods used to apply an aluminum layer for packaging, an aluminum layer having pinholes is obviously formed." Office Action page 3; emphasis supplied.

It is respectfully submitted that this assumes facts not in evidence with respect to pinhole formation.

Moreover, to assume pinholes might be present does not suggest the problem of solvent migration/ink dissolution, much less the solution to such problem in the manner of the present invention.

In this regard, Applicants further note *In re Bisley*:

Page 2 of 4

Appl. No. 10/731,937  
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The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem; and though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negative invention. 197 F.2d 355, 94 USPQ 80, 86-87 (C.C.P.A. 1952).

Nonetheless, the Examiner concludes (Office Action page 8):

With respect to the discovered aluminum layer penetration problem and using water-based primer, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. Applicant may have found that direct printing solvent-based ink onto an aluminum layer applied by vaporisation leads to dissolution of a solvent-based lacquer and uses a water-based primer to prevent the dissolution. However, the use of primer on an aluminum layer of packaging and to which ink and a protective layer are applied is suggested by the '253 patent for insuring better adhesion. While primer is suggested for a different reason, the use of a primer on an aluminum layer of packaging and onto which is applied printing is the same as what Applicant has done. Applicant cannot rely on the discovery of a problem for patentability if the subject matter as a whole suggests to do what Applicant has done, although for a different reason.

Succinctly stated, the Examiner's position appears to be that Applicants might have done what they did for some unstated reason and, thus, would have inherently solved the problem that was not known to exist. To follow the Examiner's logic, one would first have to assume that: Pinholes are present; that pinholes might cause a problem; that the problem might be solvent migration from the ink; and that the problem is of sufficient magnitude that it needs correction.

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And, only then would the means of correction be established, but they would be obvious! It is respectfully submitted that this is not the state of the law.

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000).

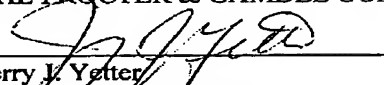
In light of the foregoing, and arguments and case law previously presented, it is submitted that the rejections constitute an impermissible hindsight reconstruction of the invention. Withdrawal of the rejections is requested.

In light of the foregoing, and arguments previously made with respect to the designated documents, early and favorable action is requested.

Respectfully submitted,

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